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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of   :   BARNABY HENDERSON, ET AL.

U.S. Serial No.   :   10/706,843

Filed   :   November 12, 2003

For   :   SYSTEM, METHOD, AND COMPUTER PROGRAM
             PRODUCT FOR STORING TEST RESULTS IN A DATABASE

Group No.   :   2167

Examiner   :   Susan F. Rayyan

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No

amendments are being filed with this request.

This request is being filed with a notice of appeal. The review is requested for the

reason(s) stated in the arguments below, demonstrating the clear legal and factual deficiency of

the rejections of some or all claims.

Claims 1-15 are pending in the application. Claims 5, 10 and 15 have been withdrawn.

Claims 1-4, 6-9, and 11-14 were rejected in the final Office Action under 35 U.S.C. §101 as

directed to non-statutory subject matter. The Advisory Action indicated that the rejection of claims

3-4, 8-9, and 13-14 are withdrawn, and these are therefore presumed to be allowed. The only issue

remaining is a statutory subject matter rejection of claims 1-2, 6-7, and 11-12.

For the convenience of the panel, claim 1 reads:

> 1. (Original) A method for storing test results in a database, comprising:
> receiving test results, the test results including a plurality of test result records, each test result record associated with a test identifier, a build version identifier, and a test result identifier;
> storing the test results in a temporary storage location;
> comparing each test result record with the contents of a test result database, the test result database having a plurality of compiled test result records, each compiled test result record associated with a test identifier, a start build version identifier, an end build version identifier, and a test result identifier;
> if a test result record and a compiled test result record have matching test identifiers and matching test result identifiers, then discarding the test result record; and
> if a test result record and a compiled test result record have matching test identifiers and different test result identifiers, then modifying the end build identifier of the compiled test result record and creating a new compiled test result record in the test result database, the new compiled test result record having the same test identifier and test result identifier as the test result record, and having a start build version identifier corresponding to the build version identifier of the test result record.

The sole justification given by Examiner Rayyan for this rejection is a piecemeal analysis of one sequence of steps that Examiner Rayyan alleges would produce no tangible result. In particular, Examiner Rayyan alleges that because some test results could be discarded, the claimed process has no tangible result. Examiner Rayyan's analysis is legally deficient.

As clearly stated in MPEP 2106, "[o]ffice personnel must treat each claim as a whole" (emphasis added). This principle is followed in *In re Iwahashi*, 888 F.2d 1370, 1374-75, 12 USPQ2d 1908, 1911-12 (Fed. Cir. 1989), cited with approval in *Alappat*, 33 F.3d at 1544 n.24, 31

USPQ2d at 1558 n.24." (emphasis added). As the Examiner's analysis does not consider the results of the claimed process as a whole, the rejection is improper.

Claim 1, taken as a whole, describes a method for storing test results in a database, which is clearly a tangible result and practical application, and has an additional advantage in that test results having the same test identifiers and test result identifiers as a previous test need not be stored, so that the results database is smaller than if a conventional process of storing every result were followed. In this way, the very step of not storing certain results has both a tangible result and a practical advantage over other methods. Such advantages are described, for example, in paragraphs 0045-0053 of the specification as filed. Claim 1 specifies that received test results are stored in a temporary storage location before any further processing -- this is clearly a tangible result, even if some results are discarded later.

Examiner Rayyan argues that it is an "inevitable possibility" that a comparison between the claimed test result record and the claimed compiled test result record would result in "no matching test identifier", and that because this possibility is not explicitly addressed in Claim 1, the claim as a whole "does not provide real world results for all possible results from the comparison step." This reasoning is similarly legally deficient and is also factually deficient, even ignoring that an "inevitable possibility" is an oxymoron.

Claims 1, 6, and 11 addresses those embodiments where specific record modifications are made depending on whether or not the test result has changed for a given matching test identifier. In the sort of real-world example Examiner Rayyan appears to require, if only the same set of tests are re-run, then there is no "inevitable possibility" that there will be no matching test identifier as alleged

by Examiner Rayyan, and every comparison will result in either a modification of a record, in the event of different results, or no modification, in the case of matching results. This provides advantages as described above.

There is no legal requirement at all that these claims be drawn to narrower embodiments. The Examiner's rejection is not based on the claim language itself, but because the Examiner proposes a hypothetical in which she suggests there would be no "tangible" results.

Dependent claims 3-4, 8-9, and 13-14 (to which the rejections are now withdrawn) address other embodiments in which additional or new tests are run, as described in the specification, so that there is no matching test identifier. When this is the case, new records are created. As described in the specification, this function can be performed separately from the initial comparisons, and this function is claimed as a further limitation to the respective independent claims. There is no legal basis for requiring that this narrower embodiment be recited in the independent claims.

Examiner Rayyan states in her Advisory Action that "Each possible branch of the decision tree within the claim must be addressed and each branch must be statutory in order for the claim to be stauatory [*sic*]." Each branch of the "decision tree" within the claim is, in fact, within the claim, and the statement that "each branch must be statutory in order for the claim to be statutory" is clearly legally incorrect. The courts and MPEP are clear that the claim is analyzed as a whole, not the individual limitations. Few limitations in any method claim of any issued patent, standing alone, would produce a concrete, tangible, and practical result.

Examiner Rayyan makes the statement that "The claim does not provide a tangible result for all possible results from the comparison step." This statement is incorrect, as described above, but

also is not a requirement for patentability. There is no basis in statute, rule, or common law for

Examiner Rayyan's novel "all possible results" test, and the rejection is legally deficient.

Claim 6 is drawn to data processing system having at least a processor and accessible

memory, and any suggestion that this is not statutory subject matter is also legally deficient.
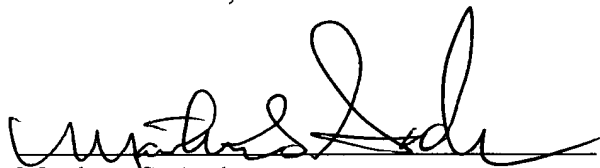

CONCLUSION

As a result of the foregoing, the Applicant asserts that the claims in the Application are in

condition for allowance over all art of record, and that the rejections are both factually and legally

deficient, and respectfully requests this case be returned to the Examiner for allowance or,

alternatively, further examination.

The Commissioner is hereby authorized to charge any additional fees connected with this

communication or credit any overpayment to Munck Butrus Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

Date: 2|16|7

Matthew S. Anderson
Registration No. 39,093

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *manderson@munckbutrus.com*